



## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

#### Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Matters Related to First Inventor to File

**AGENCY:** United States Patent and Trademark Office, Department of Commerce.

**ACTION:** Notice of information collection; request for comment.

**SUMMARY:** The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on the extension and revision of an existing information collection: 0651-0071 (Matters Relating to First Inventor to File). The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

**DATES:** To ensure consideration, comments regarding this information collection must be received on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

**ADDRESSES:** Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information:

- *Email:* [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov). Include "0651-0071 comment" in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Kimberly Hardy, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450

**FOR FURTHER INFORMATION CONTACT:** Requests for additional information should be directed to Parikha Mehta, Legal Advisor, Office of Patent Legal Administration, United

States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-3248; or by email to Parikha.Mehta@uspto.gov with “0651-0071 comment” in the subject line of the message. Additional information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

## **SUPPLEMENTARY INFORMATION:**

### **I. Abstract**

The United States Patent System uses a ‘first to file’ system, as introduced by the Leahy-Smith America Invents Act (AIA) which was enacted into law on September 16, 2011. To determine the first inventor to file, information is needed in order to identify the inventorship and ownership, or obligation to assign ownership, of each claimed invention on its effective filing date. Section 3 of the AIA, *inter alia*, amended 35 U.S.C. 102 and 103 consistent with the objectives of the AIA, including the conversion of the United States patent system from a “first to invent” system to a “first inventor to file” system. The changes in section 3 of the AIA went into effect on March 16, 2013, but apply only to certain applications filed on or after March 16, 2013.

This information collection covers information required by 37 CFR 1.55(k), 1.78(a)(6), and 1.78(d)(6) to assist the USPTO in determining whether an application is subject to 35 U.S.C. 102 and 103 as amended by Section 3 of the AIA, or 35 U.S.C. 102 and 103, in effect on March 15, 2013.

### **II. Method of Collection**

The items in this information collection may be submitted by mail, facsimile, hand delivery, or via the Patent Electronic Systems (EFS-Web or Patent Center) .

### **III. Data**

*OMB Control Number:* 0651–0071.

*Form Number(s):* None.

*Type of Review:* Extension and revision of a currently approved information collection.

*Affected Public:* Private sector; individuals or households.

*Estimated Number of Respondents:* 99 respondents per year.

*Estimated Number of Responses:* 144 responses per year.

*Estimated Time per Response:* The USPTO estimates that the responses in this information collection will take the public 2 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO.

*Estimated Total Annual Respondent Burden Hours:* 288 hours.

*Estimated Total Annual Respondent Hourly Cost Burden:* \$115,200.

Table 1: Total Hourly Burden for Private Sector Respondents

| Item No. | Item                                | Estimated Annual Respondents | Responses per Respondent | Estimated Annual Responses | Estimated Time For Response (hours) | Estimated Burden (hour/year) | Rate <sup>1</sup> (\$/hour) | Estimated Annual Respondent Cost Burden |
|----------|-------------------------------------|------------------------------|--------------------------|----------------------------|-------------------------------------|------------------------------|-----------------------------|---|
|          |                                     | (a)                          | (b)                      | (a) X (b) = (c)            | (d)                                 | (c) x (d) = (e)              | (f)                         | (e) x (f) = (g)                         |
| 1        | Submissions Under CFR 1.55(k)       | 47                           | 1.5                      | 71                         | 2                                   | 142                          | \$400                       | \$56,800                                |
| 2        | Submissions Under 37 CFR 1.78(a)(6) | 37                           | 1.5                      | 56                         | 2                                   | 112                          | \$400                       | \$44,800                                |
| 3        | Submissions Under 37 CFR 1.78(d)(6) | 9                            | 1.5                      | 14                         | 2                                   | 28                           | \$400                       | \$11,200                                |
|          | <b>Total</b>                        | <b>96</b>                    |                          | <b>141</b>                 |                                     | <b>282</b>                   |                             | <b>\$112,800</b>                        |

Table 2: Total Hourly Burden for Individuals or Households Respondents

| Item No. | Item | Estimated Annual Respondents | Responses per Respondent | Estimated Annual Responses | Estimated Time For Response (hours) | Estimated Burden (hour/year) | Rate <sup>2</sup> (\$/hour) | Estimated Annual Respondent Cost Burden |
|----------|------|------------------------------|--------------------------|----------------------------|-------------------------------------|------------------------------|-----------------------------|---|
|          |      | (a)                          | (b)                      | (a) X (b) = (c)            | (d)                                 | (c) x (d) = (e)              | (f)                         | (e) x (f) = (g)                         |

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<sup>1</sup> 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/ journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour.

<sup>2</sup> 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/ journal->

| Item No. | Item                                | Estimated Annual Respondents | Responses per Respondent | Estimated Annual Responses | Estimated Time For Response (hours) | Estimated Burden (hour/year) | Rate <sup>2</sup> (\$/hour) | Estimated Annual Respondent Cost Burden |
|----------|-------------------------------------|------------------------------|--------------------------|----------------------------|-------------------------------------|------------------------------|-----------------------------|---|
|          |                                     | (a)                          | (b)                      | (a) X (b) = (c)            | (d)                                 | (c) x (d) = (e)              | (f)                         | (e) x (f) = (g)                         |
| 1        | Submissions Under CFR 1.55(k)       | 1                            | 1                        | 1                          | 2                                   | 2                            | \$400                       | \$800                                   |
| 2        | Submissions Under 37 CFR 1.78(a)(6) | 1                            | 1                        | 1                          | 2                                   | 2                            | \$400                       | \$800                                   |
| 3        | Submissions Under 37 CFR 1.78(d)(6) | 1                            | 1                        | 1                          | 2                                   | 2                            | \$400                       | \$800                                   |
|          | <b>Total</b>                        | <b>3</b>                     |                          | <b>3</b>                   |                                     | <b>6</b>                     |                             | <b>\$2,400</b>                          |

*Estimated Total Annual Respondent (Non-hourly) Cost Burden: \$8.* sThere are no capital start-up, filing fees, recordkeeping, or maintenance costs associated with this information collection. sHowever, the information collection may have annual (non-hour) costs in the form of postage costs.

Although the USPTO prefers that the items in this information collection be submitted electronically, responses may be submitted by mail through the United States Postal Service (USPS). sThe USPTO estimates that 1% of the items will be submitted in the mail resulting in 1 mailed item. The USPTO estimates that the average postage cost for a mailed submission, using a Priority Mail 2-day flat rate legal envelope, will be \$8.25. Therefore, the USPTO estimates \$8 in postage costs associated with this information collection.

#### IV. Request for Comments

The USPTO is soliciting public comments to:

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issue/2019-report-of-the-economic-survey. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour.

- a) Evaluate whether the collection of information is necessary for the proper performance of the functions of the Agency, including whether the information shall have practical utility;
- b) Evaluate the accuracy of the Agency's estimate of the burden of the collection of information, including the validity of the methodology and assumptions used;
- c) Enhance the quality, utility, and clarity of the information to be collected; and
- d) Minimize the burden of the collection on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, telephone number, email address, or other personal identifying information (PII) in a comment, be aware that the entire comment—including PII —may be made publicly available at any time. While you may ask in your comment to withhold PII from public view, USPTO cannot guarantee that it will be able to do so.

Kimberly Hardy,

Information Collections Officer,

Office of the Chief Administrative Officer,

United States Patent and Trademark Office.

[FR Doc. 2021-21724 Filed: 10/4/2021 8:45 am; Publication Date: 10/5/2021]